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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,455	08/13/1999	Michael P. Daniels	54642USA1A	4367

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/367,455

Applicant(s)

DANIELS ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/1/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. In view of the requirement of MPEP 706.07(b) that the claims be able to be finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114 in an RCE, the finality of the office action mailed 4/19/04 is WITHDRAWN.

2. The amendment of 6/1/04 is non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003. (see 68 Fed. Reg. 38611, June 30, 2003). In order for the amendment document to be compliant, correction of the following item is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

The amendment of 6/1/04 is non-compliant because A COMPLETE LISTING OF ALL OF THE CLAIMS IS NOT PRESENT. Claim 7 is not listed. A listing such as was done with claim 21 appears to cure this defect, i.e. "claim 7 DELETED".

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the Non-compliant amendment is a PRELIMINARY AMENDMENT, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 USC 132, and this ONE MONTH time limit is not extendable.

If the non-compliant amendment is a reply to a NON-FINAL OFFICE ACTION, (including a submission for an RCE), and since the amendment appears to be a bona fide attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).

If the amendment is a reply to a FINAL-REJECTION, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

3. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but

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before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/04 has been entered.

4. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 2-6 depend from claim 1 but recite "The wet stick pressure sensitive adhesive". It is unclear if claims 2-6 require the packaging of the instant claim 1 or if they are directed to the psa per se sans packaging. The scope of the claims therefore can not be determined.

5. Claims 2-6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 is directed to the claimed article. Claims 2-6 are directed to the PSA per se. The PSA can be in no package or packaged other than in a thermoplastic in claims 2-6. This constitutes a broadening of the scope of the claimed invention which is contrary to the requirement that dependent claims further limit the claim from which they depend.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 8, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4569960 Blake.

Blake discloses a psa and method of making it which fall within the scope of the instant claims at the abstract; column 2, lines 42-68; column 3, lines 1-68; column 4, lines 1-18; column 7, lines 1-31; column 8, lines 1-31; the table of columns 11-12, particularly examples 73-75; and the patented claims. Applicant argues that anticipation requires identity of invention. The applicant has not shown that the psa of Blake is different than that of the instant claims. The applicant argues that the instantly claimed invention retains its "stick" properties, even in water. The instant claims recite "wet" but not wet with water. The applicant argues the definition of water dispersibility. The instant claims do not exclude water dispersibility. The examiner would point out that water dispersible resins are commonly applied to substrates in the form of the aqueous dispersion, e.g. latex paints/adhesives. The substrate is necessarily wet in such applications and the resin still binds to the substrate. Thus, the reference water

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dispersible psa would have been expected to stick to wet substrates. The applicant provides no probative evidence to the contrary which is commensurate in scope with the instant claims and the cited prior art. The presumption made in the applicant's arguments is therefore not persuasive. Claims 2-6 continue to be drawn to the same invention, i.e. the "wet stick pressure sensitive adhesive" per se though they depend from claim 1. This rejection still applies for the reasons stated in the prior office action and the examiner's answer and this rejection was affirmed by the decision by the Board of Appeals of 9/26/03.

The substrate will be necessarily wet when the aqueous adhesive of Blake is coated onto it, which reads on the instant claim 22. The method of making the composition of Blake is not required to have solvents and therefore reads on the instant claim 8. The sections relied on by the applicant teaching the use of solvents are not representative of the teachings of the reference as a whole. See column 3, lines 19-38 which requires no solvent.

8. Claims 1-6, 8-9, and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4569960 Blake in view of US Pat. No. 5787544 Meade.

Blake discloses a psa and method of making it which fall within the scope of the instant claims at the abstract; column 2, lines 42-68; column 3, lines 1-68; column 4, lines 1-18; column 7, lines 1-31; column 8, lines 1-31; the table of columns 11-12, particularly examples 73-75; and the patented claims. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients and amounts thereof in the psa of the patentee

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because they are encompassed by the patentee and would have been expected to give a psa having the properties of the psa of the patentee. The applicant argues that the instantly claimed invention retains its "stick" properties, even in water. The instant claims recite "wet" but not wet with water. The applicant argues the definition of water dispersibility. The instant claims do not exclude water dispersibility. The examiner would point out that water dispersible resins are commonly applied to substrates in the form of the aqueous dispersion, eg latex paints/adhesives. The substrate is necessarily wet in such applications and the resin still binds to the substrate. Thus, the reference water dispersible psa would have been expected to stick to wet substrates. The applicant provides no probative evidence to the contrary which is commensurate in scope with the instant claims and the cited prior art. The presumption made in the applicant's arguments is therefore not persuasive. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to envelop the composition of Blake in a thermoplastic pouch according to the instant claims for storage purposes or for selling the product to another company who wished to use it to make the tape discussed by Blake because such thermoplastic pouches are known for storing aqueous dispersions of binder as taught by Meade at column 3, lines 31-46 and the benefits discussed by Meade would have been expected in storing the aqueous PSA of Blake prior to use or prior to selling the PSA per se. That the inventor would desire to sell the PSA per se is evidenced by the fact that the Blake patent claims this adhesive per se. To sell it to another party it would necessarily need to be packaged and shipped. For example, it would be desirable to eliminate spilling in adding the aqueous

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adhesive of Blake to the machine in which the final tape is made and it would be desirable to eliminate shipping costs by reducing the weight of the containing holding the aqueous dispersion of adhesive of Blake and it would be desirable to reduce the weight of containers of the adhesive of Blake so that workers could handle them more easily. Further benefits would readily be apparent to the ordinary skilled artisan for the packaging described by Meade. The flexible packaging described by Meade falls within the scope of the instantly claimed "enveloping". It is noted that the ordinary skilled artisan would interpret "polymeric" and "flexible" of Meade, column 3, lines 31-34 as meaning "thermoplastic" because a thermoset would not be "flexible". It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make the flexible container from the polymers of the instant claims 11-12 and 14-15 because these are commonly available film forming polymers which are encompassed by "polymer" of the disclosure of Meade which would have been expected to form a flexible container which could contain the aqueous dispersion of Blake by the ordinary skilled artisan. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to coat a wet substrate with the adhesive of Blake because the substrate will necessarily become wet with the aqueous dispersion of Blake coated onto it. It will make no difference if the substrate is wet prior to adding the adhesive of Blake to the substrate because the adhesive of Blake is an aqueous dispersion and is itself already wet. There will merely be a little more water to evaporate to leave the final film. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the adhesive of Blake in plastic labels/stickers having a release layered

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backing which are commonly commercially available today because column 13, lines 27-39 encompass the use of the adhesive in situations in which PSAs are typically used to give the improved results of the PSA of Blake. Thus, the well known plastic stickers/labels with a backing release sheet and employing the PSA of Blake are encompassed by Blake and would fall within the scope of the "enveloping" of the instant claims. No unexpected results are seen for this. It is not seen that the monomers of the patentee do not form the instantly claimed "prepolymeric syrup" of claim 10.

"Solventless" is addressed above with regard to claim 8.

9. Claims 10 and 24 are allowable over the prior art considered by the examiner.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

June 9, 2004



Patrick Niland
Primary Examiner
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